

DOCKET NO.: MSFT-0204/155639.1
Application No.: 09/677, 443
Office Action Dated: March 3, 2003

PATENT

REMARKS

Claims 1-23 are pending in this action. Claims 1-23 were rejected.

Claim Rejections Under 35 USC § 103(a)

Claims 1-4, 6-7, 9-16, and 19-23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over **Montulli** (US Patent No. 5,826,242) in view of **SP** (The State Pattern).

Applicants have considered the references and the examiner's analysis and respectfully disagree.

Applicants respectfully submit that the examiner has failed to establish a *prima facie* case of obviousness. Applicants request that the examiner reconsider the rejection for in that the references cited by the examiner do not teach all of the elements of the claimed invention and that the examiner has not considered the claimed invention as a whole, but rather has used Applicants' application as a template to pick and choose elements from the prior art without providing a proper motivation to combine the prior art references.

Applicants submit that "all words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Royka*, 180 USPQ 580 (CCPA 1974); *see also* MPEP 2143.03. Here, Applicants submit that the Examiner has not considered the claim language, in claim 1 for example, that:

Independent claim 1, for example, recites:

maintaining the set of states associated with said object and state transitions for indicating valid transitions among states in the set of states and maintaining an indication of a current state of said object wherein said current state is a state selected from said set of states;

providing said object, an indication of said current state, and an indication of selected state transitions based on said current state to said second computer whereby the second computer

may only perform the state transitions based on said selected state transitions.

(Emphasis added.) Independent claims 10 and 19 have similar limitations. For example, claim 10 recites:

a data structure for at least one object in a set of objects in said object management system, comprising for said at least one object *a set of states in which said object may be maintained, a set of transitions between said states, and a current state;*

computer-readable server instructions that receive requests from a client for said object and *retrieve from said data structure at least a subset of transitions between states, where said subset of transitions is based upon transitions out of the current state;* and

computer-readable server instructions that return to said client an indication of at least the subset of transitions between states.

(Emphasis added.) For example, claim 19 recites:

transmitting the request to a server that maintain a data structure for the selected object comprising *a set of states in which the object may exist, a set of transitions between said states, and a current object state, whereby the server provides an indication of a subset of transitions between states, where said subset of transitions is based upon transitions out of the current object state;* and

providing an indication of *operations that may be performed upon said object where said operations are based upon the subset of transitions provided by the server.*

The examiner has indicated that Montulli does not explicitly “teach state transaction, current state.” The examiner then relies on The SP for the purported teaching of “transaction, current state.” Action p.2. However, the Examiner has provided no citation from any of the cited references for the proposition that either Montulli or SP teach:

providing said object, an indication of said current state, and an indication of selected state transitions based on said current state to said second computer whereby the second computer may only perform the state transitions based on said selected state transitions.

as recited in claim 1. Additionally, the examiner provided no reference for the limitation that “a subset of transitions between states” are provided as claimed in claim 10 of the present application. Finally, the examiner provided no reference for that teaches “providing an indication of operations that may be performed upon said object where said operations are based upon the subset of transitions” as claimed in claim 19. Accordingly, even if Montulli and SP were properly combined, neither Montulli, nor SP, nor the combination suggest or teach the invention as recited in independent claims 1, 10, or 19.

Regarding the Applicants second reason for overcoming the rejection, the purported motivation to combine the references provided by the examiner is circular wherein it is stated, for example, that “it would have been obvious to apply the teachings of SP to Montulli in order to put all behavior of states in a single object.” This motivation appears to be nothing more than a conclusion that the combination would have been obvious because it would have been obvious without providing an explanation of why the combination is obvious. Moreover, the statement “in order to put all behavior of states in a single object” misses the mark. Rather, the claims, for example, claim 10 recite “a subset of transitions between states” and not putting *all* of the states in a single object.

Inasmuch as claims 2-4, 6-7, 9, 11-16, and 20-23 depend from claims 1, 10 and 19, Applicants submit that they also patentably define over the references for at least the reasons outlined above.

Claims 8 and 18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Montulli in view of SP and further in view of LTD (State transition control procedure for connection www browser and server in Internet – involves searching transition path to attain target condition, based on which transition of controlled object is controlled).

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Inasmuch as claims 8 and 18 depend from independent claims 1 and 10, Applicants submit that they also patentable define over the cited references at least for the reasons outlined above in connection with the independent claims.

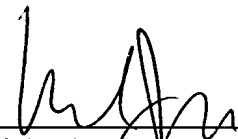
Claims 5 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Montulli in view of SP and further in view of Francis (US. Patent. 6,182,092 B1).

Inasmuch as claims 5 and 17 depend from independent claims 1 and 10, Applicants submit that they also patentable define over the cited references at least for the reasons outlined above in connection with the independent claims.

CONCLUSION

A Notice of Allowance for claims 1-23 is respectfully solicited.

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